

## **REMARKS**

The Office Action mailed July 6, 2005 has been carefully considered along with the references cited therein. In the subject Office Action, the Examiner objected to claim 26. Claim 26 was also rejected under 35 U.S.C. § 102(b) as being anticipated by Viollaz (U.S. Patent No. 5,447,311). Claims 6-7, 10 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Elkins (U.S. Design Patent No. D244,558) in view of Viollaz. Claims 6-7, 10 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Elkins in view of Golden (U.S. Patent No. 6,551,200) and Viollaz. Claims 9 and 21-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Elkins in view of Viollaz as applied to claims 6-7, 10 and 20 above, and further in view of Motomiya (U.S. Patent No. 4,438,931).

The Examiner relies on a design patent to Elkins as the main reference to reject all pending claims. Elkins is directed to the design of a muscle back iron. The Examiner combines Elkins with Viollaz, which is directed to a hollow iron, and with Golden, which discloses a club having a thicker lower portion having recesses that are visible from an exterior of the club head to reject the pending claims. For the requisite suggestion to modify, the Examiner contends that it would have been obvious to modify the head of Elkins to have a cavity filled with polyurethane to provide vibration dampening. The Examiner further contends that it would have been obvious to modify the head of Elkins to have a cavity that is not visible from an exterior of the club to prevent the filling material from inadvertently exiting the cavity.

Applicant's claims are directed a golf club head that looks like a muscle back iron from the exterior, but the club head includes a cavity. As stated in Applicant's BACKGROUND OF THE INVENTION, muscle back irons require more consistent ball striking capability to play well using them. Therefore, many golfers feel a sense of prestige carrying muscle back irons. A muscle back iron does little good in one's golf bag, however, if one cannot consistently strike the ball well. Accordingly, the inventor developed a golf club that has the look of a muscle back iron while providing the forgiveness of a cavity back iron. The references that have been provided by the Examiner fail to teach or suggest such a golf club head.

**Claim 20 from which claims 6, 7, 9, 10 and 21 depend**

“Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” MPEP 2143.01. In the instant Office Action, the Examiner has failed to provide a proper teaching, suggestion, or motivation to combine Elkins with Viollaz or Golden to produce the invention of claim 20. In rejecting claim 20, the Examiner contends that it would have been obvious to modify the head of Elkins to have a cavity filled with polyurethane to provide vibration dampening and that it would have been obvious to modify the head of Elkins to have a cavity that is not visible from an exterior of the club to prevent the filling material from inadvertently exiting the cavity. Each of the Examiner’s proposed motivations to combine Elkins and Viollaz are directed to an insert in a cavity of the club head, but claim 20 does not recite a material disposed in the cavity. Accordingly, the Examiner has not provided a teaching, suggestion or motivation to produce the invention of claim 20.

If the Examiner’s proposed modification renders the reference unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See MPEP 2143.01. As argued in the last response, providing a cavity in the muscle back iron of Elkins would render the club head unsatisfactory for its intended purpose since a golfer would not be able to “work” the golf ball as easily. Working the golf ball was described in Applicant’s BACKGROUND OF THE INVENTION section. The Examiner takes issue with Applicant’s earlier argument with regard to the impropriety of the combination of Elkins and Viollaz by arguing that there can be other reasons to combine references. The Examiner then cites the reason as adding shock absorbing abilities. As indicated above, claim 20 does not recite a material disposed in the cavity.

Additionally, even though there can be other reasons to combine references, the proposed combination or modification cannot render the reference being modified unsatisfactory for its intended purpose. See MPEP 2143.01. As explained above, a muscle back iron allows the golfer to work the ball more easily, if he or she is skilled enough. By modifying golf club head in Elkins to include a cavity, the ball cannot be worked as easily. Accordingly, it does not matter that there may be other reasons to combine Elkins and Viollaz, the suggested combination would require a substantial

reconstruction and redesign of the club head shown in Elkins and the reconstruction would change the basic principle under which the club head in Elkins was designed to operate.

**Claim 22 from which claims 23 and 26 depend**

Claim 26 has been amended to correct its dependency.

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01. When rejecting claim 22, the Examiner argues that it would have been obvious to modify the head of Elkins to have a cavity that is not visible from an exterior of the club to prevent the filling material from inadvertently exiting the cavity. This reasoning is tenuous. The insert comprising a high-rebound material could just as easily remain a cavity that is visible from the exterior of the golf club if the cavity and/or the insert were properly shaped. For example, Rife (2003/0139225), which was previously cited by the Examiner, shows in FIG. 15 an insert 830 retained in a cavity by sides 832. The cavity is visible from an exterior of the golf club.

Furthermore, as stated above with regard to claim 20, modifying the club head of Elkins to include a cavity would greatly reduce a golfer's ability to work the ball, which is an intended function of a muscle back iron.

As shown above, the Examiner has failed to establish a *prima facie* showing of obviousness with regard to the pending claims. Accordingly, Applicant requests the removal of the rejections.

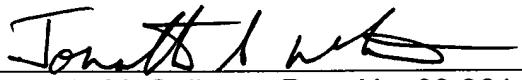
**CONCLUSION**

All formal and informal matters having been addressed, it is respectfully submitted that this application is in condition for allowance. Alternatively, if the Examiner is of the view that the application is not in clear condition for allowance, it is requested that the Examiner telephone the undersigned for purposes of conducting a telephone interview to resolve any outstanding differences. Accordingly, an early notice of allowance is earnestly solicited.

Respectfully submitted,

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October 6, 2005  
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Under 37 C.F.R. § 1.8, I certify that this Amendment is being

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